# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/615,513 | 07/08/2003 | R. Bruce Wallace | 15929ROUS02U | 9214 |

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| 34645          7590          09/14/2007 | | |

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| EXAMINER |
|---|
| PATEL, NIRAV B |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2135 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 09/14/2007 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

john@gorecki.us

| | Application No. | Applicant(s) |
|---|---|---|
| ***Advisory Action***<br>***Before the Filing of an Appeal Brief*** | 10/615,513 | WALLACE ET AL. |
| | Examiner | Art Unit | |
| | Nirav Patel | 2135 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED <u>27 August 2007</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires <u>3 </u>months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *None*.

   Claim(s) objected to: *None*.

   Claim(s) rejected: *1-7,9-11 and 13-25*.

   Claim(s) withdrawn from consideration: *None*.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

   <u>See continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

Continuation of 11 does NOT place the application in condition for allowance because: Applicant's arguments filed 08/27/07 have been fully considered but they are not persuasive.

Regarding to the applicant's argument that Hamilton does not teach or suggest "a security policy implementation point (SPIP) connected between the network and the one or more programmable logic controllers to isolate the one or more programmable logic controllers and associated factory machines from the network". Examiner disagrees with the applicant since Hamilton teaches a system for an industrial control environment as shown in Fig. 1. An access tool 20 interacts with one or more industrial control components 24 via a network 30. The access tool interacts with the industrial control components 24 which include programmable logic controllers (PLCs), whereas the network includes local factory networks. As shown in Fig. 2, the controller 120 communicates to one or more client systems 120 across a local factory network. The controller 120 also communicates to and controls various Input/Output subsystems 140 (e.g. analog, digital, programmed/intelligent I/O modules, other programmable controllers, etc.). Further, an editor tool having an associated recording component logs real time activity of the tool as shown in Fig. 7. Various status (such as the program, PLC data table, PLC status, forcing status, communications status, fault status, batch or event status, and/or other type of status affecting PLC operations or interactions) associated with the PLCs can be monitored and logged in the repository. In addition, Hamilton teaches the security operations associated with the access tool as shown in Fig. 6. The one or more security operations employ encryption technique, authentication/authorization technique, and/or other security measures when communicating activity data over a network. In addition, such security layers also applied when communicating with, or storing data in local and/or remote storage location. The security layers include one or more trust components to provide machine authentication, an encryption component to provide user authentication, authorization and a policy component to facilitate varying levels of data access (e.g. restrict data access of specified machines and/or persons according to selected security policies). The security layers include virtual private networks mitigating unauthorized access, LAN-locked layers mitigating access from networks etc. Therefore, Hamilton teaches the controller, includes the policy component, which isolates the one or more programmable logic controllers from the network and thus discloses the claim subject matter. Amara teaches the policy database (initiating security gateway- intermediate) connected between the local area network and the one or more computers/devices, which creates a connection (tunnel) between the devices and the network as shown in Figs. 1, 2. The network backbone 120 enables the devices to communicate with the network 170. The home agent 130 provides access control mechanism between the devices and the network 170. Therefore, the combination of Hamilton and Amara teaches the claim limitation. The examiner recognizes that obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to on of ordinary skill in the art. See In re Fine, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ 2nd 1941 (Fed. Cir 1992). In fact, Hamilton and Amara do not need to disclose anything over and above the invention as claimed in order to render it unpatentable or anticipate. A recitation of the intended use of the claimed invention must result in structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claimed limitations. In this case, the combination of Hamilton and Amara teaches the claim limitation. The combination is sufficient as one of ordinary skill in the art at the time the invention was made, since one would have been motivated to provide scalable network access system [Amara, paragraph 0006, 0007].

Further, Applicant argued, Hamilton does not address how access to a PLC should be controller (does not teach or suggest implementing a second layer of control...that will prevent someone using a management program from having access to particular PLCs). However, the limitation presented in the remark is not expressively stated in the claimed language. The Applicant is reminded that presented arguments in the remark is not considered unless stated clearly in the claim language. The Applicant is reminded that additional modification to clarify the claimed language is necessary for further consideration and distinction from the prior art.
For the above reasons, it is believed that the rejections should be sustained.

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